

Neifeld Docket No: OCLP-3-LAOR-US

Application/Patent No: 09/595,677

USPTO CONFIRMATION NO: 3948

File/Issue Date: 6/19/2000

Inventor/title: LAOR/Method of and System for Managing Promotions for Purchase
Transactions Over a Network

Examiner/ArtUnit: VAN BRAMER/3622

ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22313

37 CFR 1.705 REQUEST FOR RECONSIDERATION OF THE PATENT TERM

ADJUSTMENT

I. Statement of the Precise Relief Requested

The patentee requests that the Director change the notice of term extension under 35 USC 154(b) to 2085 days. The USPTO noted only 1912 days in its determination of patent term adjustment in the issue notification mailed 10/6/2009. The difference of 173 days results from the omission of the time in excess of three years from the filing of the application (June 19, 2000) until the filing of a request for continued examination (December 9, 2003).

II. Material Facts in Support of the Petition

1. The Director determined a 1912 day patent term extension, as noted on the determination of patent term adjustment in the issue notification mailed October 6, 2009.
2. On June 19, 2000, the applicant filed this application.
3. On February 12, 2003, the USPTO mailed a non-final rejection.
4. On June 12, 2003, the applicant was granted a 31 day extension of time to respond to an office action
5. On December 9, 2003, the applicant filed a request for continued examination.
6. On November 22, 2005, the USPTO mailed a non-final rejection.

7. On March 22, 2006, the applicant was granted a 28 day extension of time to respond to an office action
8. On September 14, 2006, the applicant filed a notice of appeal.
9. On May 22, 2008, the USPTO mailed a BPAI decision on appeal reversing the examiner.
10. The Director determined a 1692 day patent term extension, as noted on the determination of patent term adjustment mailed September 18, 2008.
11. On October 29, 2008, the applicant filed a 37 CFR 1.705 application for patent term adjustment.
12. On April 23, 2009, the Office of Petitions mailed a response to the 37 CFR 1.705 application for patent term adjustment.
13. The April 23, 2009 response noted that a decision is being held in abeyance until after the actual patent date.
14. The April 23, 2009 response gave the applicant two months from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years.
15. On October 6, 2009, US Patent 7,599,850 issued from this application.

III. Reasons Why the Relief Requested Should be Granted

The term extension applicable under the 35 USC 154 is calculated as follows:

A. 35 USC 154(b)(1)(A) - GUARANTEE OF PROMPT PATENT AND TRADEMARK OFFICE RESPONSES

1. **35 USC 154(b)(1)(A)(i)** provides that the term of the patent shall be extended 1 day for each day that the PTO fails to respond to a reply under section 111(a) within 14 months after the date on which the application was filed.

2. On June 19, 2000, the applicant filed this application. On February 12, 2003, the USPTO mailed a non-final rejection. The difference between these dates, less the permitted fourteen months, is 542 days.

3. On December 9, 2003, the applicant filed a request for continued examination. On November 22, 2005, the USPTO mailed a non-final rejection. The difference between these

dates, less the permitted four months, is 592 days.

4. On October 29, 2008, the applicant filed an application for patent term adjustment. On October 6, 2009, the USPTO mailed an issue notification containing a determination of patent term adjustment. The difference between these dates, less the permitted four months, is 220 days.

B. 35 USC 154(b)(1)(B) -GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY

5. **35 USC 154(b)(1)(B)(i)** provides that the term of the patent shall be extended 1 day for each day in excess of three years from the application filing date that the PTO fails to issue an original patent, not including any time consumed by continued examination of the application requested by the applicant under section 132(b).

6. On June 19, 2000, the applicant filed this application. On December 9, 2003, the applicant filed a request for continued examination. The difference between these dates is 173 days. This period of PTO delay, from June 19, 2003 until December 9, 2003, does not overlap with any other period of PTO delay. Therefore, consistent with the holding in *Wyeth v. Dudas*, No. 07-1492 (D.D.C. September 30, 2008), the applicant is entitled to these 173 days.

C. 35 USC 154(b)(1)(C) - GUARANTEE OR ADJUSTMENTS FOR DELAYS DUE TO INTERFERENCES, SECRECY ORDERS, AND APPEALS

7. **35 USC 154(b)(1)(C)(iii)/37 CFR 1.703(e)** provides that the term of the patent shall be extended 1 day for each day under appellate review, from the date of filing a notice of appeal to the date of a decision reversing an adverse determination of patentability of any claim.

8. On September 14, 2006, the applicant filed a notice of appeal. On May 22, 2008, the USPTO mailed a BPAI decision on appeal reversing the examiner. The difference between these dates is 617.

9. The total PTA for PTO delay is 2144 days.

D. 35 USC 154(b)(2) -REDUCTION OF PERIOD OF ADJUSTMENT FOR APPLICANT DELAY

1. On June 12, 2003, the applicant was granted a 31 day extension of time to respond to an office action.
2. On March 22, 2006, the applicant was granted a 28 day extension of time to respond to an office action.
3. The total reduction in PTA for applicant delay is 59 days.

IV. Conclusion

The net patent term adjustment is 2085 days. The Director should grant the petition to change the notice of term extension under 35 USC 154(b) from 1912 days to 2085 days.

V. Fee under 37 CFR 1.18(e)

On October 29, 2008, the applicant submitted a 37 CFR 1.705 application for patent term adjustment. The filing included an EFS credit card authorization in the amount of \$200 to pay for filing an application patent term adjustment.

The April 23, 2009 response from the Office of Petitions states: "The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required."

VI. List of Exhibits

Exhibit 1: A copy of the USPTO web site's PAIR Transaction History tab printout for United States Patent Application Number 09/595,677 showing the dates recorded by the USPTO for filing and mailing of papers in this application.

Exhibit 2: A copy of the April 23, 2009 decision from the Office of Petitions

Respectfully submitted,
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Date 10-29-2009

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BTM

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